

REMARKS/ARGUMENTS

Applicant submits the present amendment in response to the Examiner's first Office Action mailed on November 17, 2004. Pursuant to 37 C.F.R. § 1.136, Applicant requests a one-month extension of time and includes payment therefore.

In the first Office Action, the Examiner rejected Claims 1-10 as being obvious with respect to *Heath* in view of *Patel*. In particular, the Examiner combined the description of the decking plank of *Heath* with the hollow building panel having an angled support member as described in *Patel* to determine that the invention as claimed would be obvious to one of ordinary skill in the art at the time the present invention was made to put a ledge as in *Patel* in the structure of *Heath* to act as a nailing flange into the subassembly.

Applicant submits, however, that the present invention is not obvious with respect to *Heath* in view of *Patel*. More specifically, Applicant's invention as defined in the claims includes a decking plank having a downwardly projecting flange on a first end and a ledge on the opposite end of the decking plank proximate an upwardly open channel. A flange of a corresponding decking plank will therefore engage the upwardly open channel to lock the two planks together. The flange is attached proximate the upwardly open channel to secure the fence plank to the subassembly. *Patel*, on the other hand, describes a building panel having a spring tab 208 on the end opposite of the flange 220, wherein the spring tab is used to connect and lock two panels together, which is the purpose of the downwardly positioned flange in *Heath*.

As a result, Applicant submits that it is not proper to combine the building panel as described in *Patel* with the teaching of *Heath*, in that it would render *Heath* inoperative. In particular, if the teaching of *Patel* is applied to *Heath*, then a flange would extend from the bottom surface of the decking plank at the side opposite of the upwardly opening channel. The flange in this position would then engage the upwardly opening channel of the adjacent decking plank during assembly, thereby preventing the planks from properly engaging each other and creating a buckled connection that is not desired for a floor surface. Thus, *Patel* teaches away from the invention, since the Examiner's interpretation of the prior art would render the prior art or the present invention inoperable. As the courts have held, if references taken in combination would produce a "seemingly inoperative device," then such references teach away from the combination, and, thus, cannot serve as predicates for a *prima facie* case of obviousness. *In re Spinnoble*, 405

F.2d 578, 587, 160 U.S.P.Q. 237, 244 (C.C.P.A. 1969) (references teach away from combination if combination produces seemingly inoperative device). Thus, Applicant submits that Claims 1-10 of the present application are in condition for allowance.

Moreover, Applicant has additionally amended Claims 2 and 10 to further describe the location of apertures on both sides of an upstanding longitudinal wall, such that the user has the option of inserting a fastener on either side or both sides for secured connection to the subassembly or other surface. Neither *Heath* nor *Patel* describe a design for a decking plank or other building panel with apertures for selective connection to a proximate surface. Since neither reference describes a similar decking plank or corresponding ledge, Applicant submits that these claims, and those depending therefrom, are in condition for allowance.

Accordingly, reconsideration and withdrawal of the rejections of these independent claims are earnestly requested.

In view of the amendments and comments provided above, Applicant respectfully requests that the Examiner withdraw the previous rejections and that Notice of Allowability be issued.

Respectfully submitted,

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